



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/678,865 | 10/03/2003 | Kenneth J. Muderlak | 11758/213 | 1300 |

7590 10/29/2004
Adam D. Airhart
Brinks Hofer Gilson & Lione
NBC Tower, Suite 3600
P.O. Box 10395
Chicago, IL 60610

EXAMINER

PRUNNER, KATHLEEN J

ART UNIT PAPER NUMBER

3751

DATE MAILED: 10/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/678,865

Applicant(s)

MUDERLAK, KENNETH J.

Examiner

Kathleen J. Prunner

Art Unit

3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,9-13 and 16-23 is/are rejected.
- 7) ☒ Claim(s) 2,7,8,14 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 010804.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION*Drawings*

1. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference signs **mentioned** in the description: (A) **47** (note line 1 on page 6); (B) **133** (note line 30 on page 7); (C) **145** (note line 6 on page 8); and (D) **168** (note lines 13-14 on page 9). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) **not mentioned** in the description: **22** (note Fig. 16). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

Art Unit: 3751

prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to because: (A) in Fig. 9, an unidentified lead line is located above 109B on the left hand side, and "09C" should be changed to --109C--; (B) in Fig. 16, "93" and its lead line should be deleted; (C) in Fig. 17, "176", directly above 93 on the right hand side, and its lead line should be deleted; (D) in Fig. 18, "188" merely indicates space rather than a portion of a wall — it is suggested that 188 and its arrow line be deleted or a section of a wall be shown; (E) in Fig. 18, the lead line for "194" is misdirecting; and (F) Figs. 18 and 2 are inconsistent in the showing of "opening 89". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly

Art Unit: 3751

labeled as "Annotated Marked-up Drawings" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

Specification

6. The following informalities in the specification are noted: (A) on page 6, line 26, "10" should read --103--; (B) on page 7, line 12, "109" should be deleted; (C) on page 8, line 2, "141" should read --139--; (D) on page 8, line 18, "nut 157" should read --nut 159-- and "screw 159" should read --screw 157--; (E) on page 9, line 14, "40" should read --41--; (F) on page 9, line 29, "172" should read --185--; (G) on page 9, line 30, --178-- should be inserted after "second end"; (H) on page 9, line 31, "178" should read --185--; (I) on page 10, line 2, "toilet" is misspelled; (J) on page 10, line 19, --to-- should be inserted after "trying" and "in" should be deleted; and (K) on page 11, line 1, "17" should read --18--. Appropriate correction is required.

7. The following informalities in the claims are noted: (A) in claim 7, on line 2, "clamp" (second occurrence) is misspelled. Appropriate correction is required.

8. The specification is objected to as failing to provide proper antecedent basis for the claimed terminology. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). The claimed terminology which lacks such antecedent basis is as follows: (A) "a stationary appendage within tank", as called for by claim 17; and (B) "cable", as called for by claim 23. Correction is required. It is suggested that the specification be amended to include the above mentioned language.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 3751

10. Claims 4 and 16 are rejected under 35 U.S.C. 112, first paragraph, because the specification, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 4 and 16 call for "said clamp can be changed from a removably mounted configuration on said housing to a permanently mounted configuration by rotating the clamp about 180 degrees". Paragraph [0010] on page 2 of the specification also describes that "the clamp may be changed from a removably mounted configuration to a permanently mounted position by rotating a clamp about 180 degrees". However, the disclosure fails to support or describe what structural features or structural configuration of the clamp enables the clamp to be able to be changed from a removably mounted configuration on the housing to a permanently mounted configuration by rotating the clamp about 180 degrees.

11. Claims 17-23 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "When installing the actuator, the clamp 23 is placed around the overflow pipe 17 and secured thereto . . . Alternatively, the clamp may be affixed to another component in the tank or to a rod or pipe in the tank which has been installed in the tank to hold the actuator housing 21" (note ¶ 0047 on page 10), does not reasonably provide enablement for "affixing a clamp to a stationary appendage within a tank", as called for by claim 17. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

12. Claims 17-23 are also rejected under 35 U.S.C. 112, first paragraph, because the specification, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 17 and 20 call for "attaching said lever to a flap lid". However, the specification merely describes "The housing 21 comprises a lower portion or

Art Unit: 3751

base 25 and an upper portion or cover 27 having a dual part lever assembly mounted thereon" (note ¶ 0034 on page 5) and "the flush valve chain 20 is secured to the lever 121" (note ¶ 0034 on page 5). Hence, the step of "attaching said lever to a flap lid" in the method of installing the system has not been properly described.

13. Claims 17-23 are further rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 17 calls for the step of "attaching said lever to a flap lid" after the step of "rotating a(the) lever on said actuator within said tank". However, the specification merely describes the steps in the order of affixing a clamp to a component in the tank, "The housing 21 is then either removably mounted or securely locked onto the clamp 23", and "The lever 121 is then rotated to the desired position" (note ¶ 0047 on page 10). Hence, the step of "attaching said lever to a flap lid" after the step of "rotating a(the) lever on said actuator within said tank" in the method of installing the system has not been properly described.

14. Claims 17-23 are additionally rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 17 calls for the steps of "attaching said lever to a flap lid, attaching said actuator to a power source, and affixing a sensor to a surface outside of said tank". However, these steps in the method of installing the system have not been properly described (note ¶s 0047-0049 on pages 10-11).

15. Claim 20 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 20 calls for the method of installing the system to include the step of "attaching said lever to said flap lid" and further

Art Unit: 3751

defines this step as "connecting a first end of a chain to said lever and attaching a second end of said chain to said flap lid". However, this step in the method of installing the system has not been properly described (note ¶s 0047-0049 on pages 10-11).

16. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 21 calls for the steps in the method of installing the system to include "loosening a first and second lever clamp caps, rotating said lever to align with said flap lid, and tightening said first and second lever clamp caps". However, these steps in the method of installing the system have not been properly described (note ¶s 0047-0049 on pages 10-11).

17. Claim 23 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 23 calls for the step of "attaching a first end of a cable to said sensor and a second end of said cable to said actuator". However, this step in the method of installing the system have not been properly described (note ¶s 0047-0049 on pages 10-11).

18. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

19. Claims 9-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

20. Claims 9 and 11 contain a term lacking proper antecedent basis. The claims recite the limitation "said lever" in line 2 of claim 9 and line 3 of claim 11. There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 102

21. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

22. Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Schroder. Schroder discloses a flush actuator for use with a toilet having all the claimed features including a housing (constituted by the outer surface of the bushing 25, note Fig. 6) having a base (constituted by the bottom portion adjacent nut 66, note Fig. 6) and a cover (constituted by the upper or top portion, note Fig. 6), the cover having an upper surface (note Fig. 6), and a lever 68 (note Fig. 6) pivotally or rotatably coupled (at 67, note Fig. 5) to the upper surface (note Figs. 5 and 6).

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claims 1, 3, 5, 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Veal ('864) in view of Kleiser, Jr. Veal ('864) discloses an automatic flushing actuator system for a toilet having the claimed features including a sensor (constituted by sensor arrangement 26) that detects the presence of an occurrence, a receiver (constituted by printed circuit board 90) coupled to the sensor 26, the receiver 90 being disposed in a housing (note the housing closure for actuator 60 in Fig. 7 and its internal components as shown in Fig. 8A) having a base and a cover (constituted by the uppermost or top portion of the housing 60), the housing 60 having a pivotable or rotatable lever 100 mounted thereon (note Fig. 8B), a gear mechanism 93 connected

Art Unit: 3751

to the receiver 90, the gear mechanism 93 having a cam 92 that engages an actuator rod (constituted by cam follower 97) which is in contact with the lever 100 (note Fig. 8B), and a clamp (constituted by straps 88) mounting the housing 60 on a component (constituted by the overflow tube 62) in the toilet tank 20. Veal ('864) also discloses that the lever 100 is mounted to the bottom portion of the housing (note Fig. 8B). Although Veal ('864) fails to disclose that the lever is mounted to the cover or top portion of the housing, attention is directed to Kleiser, Jr., who discloses another flushing actuator system for a toilet having a housing (constituted by casing 12) in which the lever 25 is mounted to the top end portion of the housing. It would have been obvious to one of ordinary skill in the toilet art, at the time the invention was made, to mount the lever of Veal ('864) to the top portion of the housing in view of the teachings of Kleiser, Jr., in order to better dispose the lever at a higher level in the tank so that it would be easier for the user to have access thereto so as to make adjustments when circumstances demand. With respect to claim 3, it is considered that the clamp 88 of Veal is inherently permanently mounted to the housing 60. With regard to claim 5, although Veal fails to disclose that an insert is configured for placement inside the clamp 88, it is considered that to use an insert in the clamp is an obvious expedient to one skilled in the art especially when the diameter of the overflow pipe is too small for the particular clamp to be mounted thereto. With respect to claim 6, Veal further discloses that the component comprises an overflow pipe 62 and the clamp 88 is affixed to the overflow pipe 62 (note lines 10-13 in col. 6). With respect to claim 12, Veal additionally discloses that the receiver is wirelessly coupled to the sensor (note lines 34-40 in col. 5 and lines 13-21 in col. 9).

Allowable Subject Matter

25. Claims 2, 7, 8, 14 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if claims 2, 7, 8 and 14 are rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 3751

Conclusion

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bate is cited to show a lever mounted to the top of a support structure in the toilet tank.


27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kathleen J. Prunner whose telephone number is 703-306-9044. In mid to late November, 2004, the examiner's office will move to the new complex in Alexandria, Virginia. Upon moving to the new complex, the examiner's new telephone number will be 571-272-4894.

28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kathleen J. Prunner

October 25, 2004



GREGORY L. HUSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700